

Remarks

In response to the Office Action dated June 27, 2007, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. Claims 1, 7 and 8 have been amended. Support for the amendments may be found on pages 9 and 10.

101 Rejections

Independent claim 7 stands rejected under 35 USC §101 because allegedly the claimed invention is directed to non-statutory subject matter because the claim just recites a computer readable medium instead of a computer readable medium storing computer executable instructions which is executed by a processor or computer. Amended independent claim 7 now recites “[a] computer-readable medium containing instructions to be executed by a computing device for performing acts...” Claim 12 depends from amended independent claim 7. Amended independent claim 7 is now directed to statutory subject matter and the §101 rejections against claims 7 and 12 may be withdrawn.

102 Rejections

In the Office Action, claims 8 and 9 are rejected under 35 U.S.C. §102(e) as being anticipated by McDowell. Amended independent claim 8 recites in pertinent part:

“[a] method of receiving data sent from a first computing device to a plurality of second computing devices over a wireless digital packet-switched network...comprising...receiving data from **an instant messaging application running on the first computing device** over a wireless digital packet-switched network...determining a plurality of intended recipients of the data at the messaging server“...and forwarding the data from the messaging server directly to the intended recipients...”.

To anticipate, a reference must describe each and every element of the claims. (MPEP 2131). Applicants respectfully assert that McDowell fails to describe an “instant messaging application running on the first computing device” and fails to describe “determining a plurality of intended recipients of the data at the messaging server”.

On page 2, the Office Action expressly equates the wireless subscriber device **210**, WAP Gateway **136** and **IM Server** of McDowell (See Fig. 2) to the first computing device, protocol

server and instant messaging server, respectively, as recited in independent claim 8. The Office Action continues on to assert that wireless subscriber device **210** of McDowell contains and executes both an IM messaging application (a “WAP IM”) and a WAP browser and also asserts that the wireless subscriber device **210** sends data to subscriber **731** and **733** over a wireless digital packet switched network **712**. The Office Action finally asserts that wireless subscriber sends and receives information from the **IM Server** via the WAP IM while maintaining contact with a remote system via the WAP browser.

Applicants respectfully but completely disagree with the Office Action’s assertions. Applicants point out that McDowell merely describes that only a WAP browser is running on the first computing device and that the WAP browser then communicates with a WAP IM application that is resident and executing on the **IM Server**. McDowell does not describe that both a WAP IM and a WAP browser are both running on the first computing device.

In support of this distinction, Applicants respectfully point out that McDowell describes that the wireless subscriber instant messaging capability is provided through a **WAP client or a two-way SMS web page** which is *resident in the PLIM 110*. A PLIM is a server side combination gateway, IM server and presence server (FIGS 1-3, Para. 0042-0043) and is operated by the service provider.

In McDowell, the subscriber (i.e. the subscriber device **210**) goes to a web page on the *WAP IM client* operated by her wireless carrier and that the *WAP IM client* allows subscribers to carry on all of the IM activities (Para. 0092, 0098-0099). It is explicitly described that that “the WAP Client resides either on a web server inside the wireless carrier’s firewall, or behind the firewall of a PLIM system gateway site. (Para. 0098). It is further described that the *WAP IM client* is accessible via a standard web browser and that the *WAP client* provides full IM capabilities (Para. 0097).

Therefore, McDowell is clearly describing that the WAP IM client, operated at the service provider by the service provider, is running an IM application and that the wireless subscriber device **210** is merely running a WAP Browser that is accessing the WAP IM Client at the service provider in order to create an IM or Buddy lists. McDowell is not describing the subscriber device **210** is itself running both a WAP IM application and a WAP browser.

In further support, McDowell expressly and impliedly concedes that subscriber wireless device **210** does not run an embedded IM or buddy list application. McDowell states that “[i]n

the future, WAP and SMS may give way to...embedded IM and buddy lists in client wireless devices themselves". (Para. 0095). As such, McDowell is expressly confirming that embedded wireless instant messaging applications did not exist in subscriber wireless devices at the time of McDowell's filing and was merely speculating on hope to be future developments. Therefore, for this additional reason, McDowell can not be describing a messaging application running on the first computing device because McDowell states that such an arrangement did not exist at the time of the filing of McDowell. In fact, the whole point of McDowell is to provide IM functionality to mobile client devices that can not run a WAP IM application.

Therefore, when McDowell describes that the IM server allows wireless networks to send and receive instant messages from common IM platforms (Para. 46), McDowell is NOT describing or implying that subscriber wireless device **210** is sending and receiving instant messages since McDowell concedes that it can not do so. (Para. 0095). McDowell is describing that the subscriber wireless device **210** is accessing the IM server whereby a web page of the IM server is manipulated by the wireless device **210** to compose and read a message. (Para. 0092). Therefore, McDowell fails to describe a "messaging application running on the first computing device over the wireless digital packet-switched network" as recited in independent claim 8.

In his response to Applicants' previous arguments, the Examiner cites paragraph 50 and paragraph 59 of McDowell as describing conclusively that the subscriber wireless device **210** includes a messaging application. Applicants respectfully disagree.

Paragraph 0050 merely describes that the Presence Server **112** determines if a wireless device is on or off and that software on the handset **210** can indicate whether it is on or off. Software indicating that a buddy is on or off that is provided by a Presence Server is not describing that the wireless device includes "an IM messaging application running on the first computing device". As mentioned above, paragraph 0095 states that buddy lists capability embedded in the hand set does not yet exist but may in the future. A mere presence On/Off indication is not a "Buddy List".

The Office Action also points to paragraph 0059 in support. However, paragraph 0059 merely describes that the PLIM (i.e. the IM server) retrieves online presence from various IM servers and makes it available to wireless subscribers on the WAP IM client, which is located in the PLIM and not on the wireless communication device **210**. The wireless communication

device **210** is merely looking at a web page executing on the WAP IM client (e.g. the IM Server).

Applicants respectfully point out another discrepancy in McDowell. Amended independent claim 8 recites, in pertinent part, "...determining a plurality of intended recipients of the data at the messaging server and forwarding the data from the messaging server directly to the intended recipients without transmitting the data through the protocol server..."

Applicants respectfully disagree that McDowell describes that the wireless subscriber device **210** sends data to subscribers **731** and/or **733** over a wireless digital packet switched network **712** as relied upon by the Office Action. No such capability is described by McDowell. FIG. 7 and its related discussion is merely describing that merchants **731** and **733** may access the PLIM server **704** to "facilitate presence and location information between networks". (Para. 0084). The functionality of FIG. 7 and its discussion is completely separate from the discussion in McDowell concerning the interaction between the wireless communication device and the IM Server shown of FIGs. 2&3. There is no discussion of an IM message from wireless communication device **210** being forwarded to merchants **731** or **733** by the PLIM or any PLIM component. Any such assertion requires a leap of logic that the PLIM **110**, or some component thereof, forwards IM messages from the IM server to the Network API **117** and then to Merchants **731** and/or **733**. As such, McDowell fails to describe determining a plurality of intended recipients of the data at the messaging server and forwarding the data from the messaging server directly to the intended recipients without transmitting the data through the protocol server determining a plurality of intended recipients of the data at the messaging server. Therefore, amended claim 8 is allowable for at least this additional reason.

Further, Applicants respectfully point out that McDowell merely describes an IM message being sent from the IM Sever to a single recipient. McDowell does not describe "...and forwarding the data from the messaging server directly to the intended recipients..." or that the McDowell system the capability to send an IM message to multiple recipients. As such, amended independent claim 8 is allowable for at least this additional reason.

Furthermore, for prior art to anticipate within the context of §102, the prior art must contain enabling disclosure of the asserted subject matter. The mere naming or description of the subject matter is insufficient if it can not be produced without undue experimentation. (MPEP 2121.01). Since McDowell expressly describes that the technology for wireless IM capability or

for embedded IM/buddy lists in wireless devices did not exist in the art at the time of its filing (para. 0095), its mere mention is not enabling of McDowell in this respect. Because the public was not in possession of the knowledge allowing the execution of an IM application on a wireless device prior to the filing date of the instant application, McDowell is not §102 prior art for the proposition that McDowell describes that the wireless device includes “a messaging application running on the first computing device”.

Therefore, for at least the above reasons, McDowell fails to describe all of the claim elements and independent claim 8 is allowable over McDowell. Dependent claim 9 depends from an allowable independent claim 8 and is allowable for at least the same reasons.

103 Rejections

Claims 1-2 and 4-13 stand rejected as being unpatentable under McDowell in view of Doss and Parsons.

Claims 1-2, 4-6, 7 and 12

Amended independent claim 1 recites, in pertinent part:

“[a] method of sending data from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network...the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device to a instant messaging server within the private network via the protocol server over the wireless digital packet-switched network;

generating data to be sent from the first computing device to the at least one of the plurality of second computing devices within the private network, wherein data is generatable... from the second application as an instant message...the instant message being transmitted by way of the wireless digital packet- switched modem, initiating a first communication through a communication layer by the first application using a first application program interface (API) call; initiating a second communication through the communication layer by the second application using a second API call...”

In its rejection, the Office Action asserts that McDowell teaches or suggests most of the claim elements. The Office Action concedes that McDowell fails to describe that instant messaging data being sent from the first computing device to an instant messaging server within a private network via the protocol server over a wireless digital packet-switched network. The Office Action further concedes that the combination of McDowell and Parsons does not describe

initiating a request to a modem controller for access to the wireless digital packet-switched modem.

However, it is respectfully submitted that as discussed above in regards to the §102 rejections, McDowell does not describe the subject matter relied upon by the Office Action because McDowell does not describe an IM application executing on the wireless communication device **210**. For example, McDowell does not describe “initiating a second application on the first computing device, the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device...wherein data is generatable ...from the second application **as an instant message.**”

Further, neither Doss nor Parsons cures these additional deficiencies of McDowell as neither Doss nor Parsons is concerned with instant messaging. Doss is directed to a dynamically enhanced database search comprising a static database and a dynamic database. Because Doss does not address the use of an IM application on a computing device (i.e. the first computing device), Doss fails to cure this additional deficiency of McDowell.

Parsons is directed to a presence detection system for a telephone system and does not appear to describe the use of an IM Service. Therefore, since Doss, Parsons and their combination fail to cure the discrepancies of McDowell, the combination of McDowell, Parsons and Doss fail to describe each an every claim element. As such, amended independent claim 1 is allowable over the combination of McDowell, Doss and Parsons.

Amended independent claim 7 contains similar recitations and is, therefore, allowable over the combination of McDowell, Doss and Parsons for at least the same reasons. Dependent claims 2, 4-6 and 11-12 depend from an allowable independent claim 1 or 7 and are allowable for at least the same reasons.

In addition to the reasons discussed above, Applicants respectfully point out that amended independent claim 1 recites “...initiating a first communication through a communication layer by the first application using a first application program interface (API) call and initiating a second communication through the communication layer by the second application using a second API call ...” McDowell fails to describe the use of a first and second API call by the first and second applications. McDowell merely described the wireless communication device as using a WAP Browser. Further, it appears that neither Doss nor Parsons cures this additional discrepancy by describing the use of a first or second API by a first

and second application. As such, the Office Action fails to establish a prima facie case of obviousness because the combination of McDowell, Doss and Parsons fails to describe each and every claim element. Amended independent claim 1 is therefore allowable over the combination of McDowell, Doss and Parsons for at least this additional reason.

In regard to claim 5, the Office Action concedes that the combination of McDowell, Doss and Parsons fails to disclose that the user identifier comprises one of a group of allowed recipients, the method further comprising detecting at the instant messaging server whether the user identifier is of the group of allowed recipients, and delivering the message to the recipient only when the user identifier is of the allowed group. The Office action proceeds by asserting Official Notice that such a method is “well known and expected in the art”.

Official Notice unsupported by documentary evidence is permissible only where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well known at the time of filing as to defy dispute. (MPEP 2144.03). Specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *Id.* “Facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice. *Id.*, (quoting *In re Eynde*, 480 F.2d 1364, 1370 (CCPA 1973)).

Applicants disagree with the Examiner’s Official Notice. Being a question of the state of the art at the time of filing in 2001, Applicants respectfully assert that the Office Notice fails to rise to the standard of unquestionable demonstration as being well known such as to defy dispute. As such, Applicants demand a written notice to produce a reference. (MPEP 2144.03(C)). Because the combination of McDowell, Doss and Parsons is conceded not to describe “detecting at the instant messaging server whether the user identifier is of the group of allowed recipients, and delivering the message to the recipient only when the user identifier is of the allowed group” and the Official Notice is inadequate, then Claim 5 is allowable over the combination of McDowell, Doss, Parsons and the Official Notice.

Claims 10 and 13

In regards to claims 10, amended independent claim 10 recites, in pertinent part:

“[a] system for sending data over a wireless digital packet-switched network from a first computing device to at least one of a plurality of second computing devices...comprising...the first computing device implementing ...an instant message application that generates instant messages...and wherein the protocol server ...receives the instant messages and forwards them to the instant messaging server for delivery...”.

For the reasons discussed above in regards to the §102 rejections, McDowell is not describing the first computing device implementing ...**an instant message application that generates instant messages**...and wherein **the protocol server ...receives the instant messages** and forwards them to the instant messaging server for delivery. McDowell merely accesses an IM web page via a WAP browser. The IM server hosting the web page then generates the instant messages. The first communication device is not implementing an instant messaging application wherein the protocol server is receiving the instant message. The instant message is being generated on the IM server which is on the back side of the protocol server. Therefore, McDowell fails to describe the subject matter for which McDowell was asserted. As neither Doss nor Parsons discusses the use of an IM application on a wireless device, Doss fails to cure this particular deficiency of McDowell.

Therefore, Applicants respectfully assert that the combination of McDowell, Doss and Parsons fails to describe all of the claim elements of amended independent claim 10. Amended independent claim 10 is therefore allowable over the combination of McDowell, Doss and Parsons. Claim 13 depends from an allowable independent claim 10 and is allowable for at least the same reasons.

Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

No fees are believed due other than for a one month extension. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025

Respectfully submitted,

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